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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,085	11/13/2001	Masami Oishi	Q67159	6327

7590 12/29/2004

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EXAMINER
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AGUSTIN, PETER VINCENT

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/987,085

Applicant(s)

OISHI ET AL.

Examiner

Peter Vincent Agustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-17 is/are rejected.
- 7) ☒ Claim(s) 4 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. Replacement drawings for Figures 1 & 2 were received on September 13, 2004. These drawings are acceptable.

2. The drawings are objected to because of the following informalities:

Figure 3, element 4: "RE SIGNAL" should be --RF SIGNAL--.

Figure 4, step S11: "POSITIOIN" should be --POSITION--.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 & 6-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al. (EP 1,017,058 A2).

In regard to claim 1, Yoshida et al. disclose an optical recording apparatus (figure 3) for recording an information data signal on an optical recording medium (figure 3, element 1), comprising: a position identifying portion for identifying the position of a control data recording area where control data regarding recording of said information data signal is recorded (figure 3, element 11); a pre-pit signal detecting portion (figure 3, element 17) for reading a predetermined

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section of said control data recording area to detect a pre-pit signal; and a generating portion (figure 3, elements 14 & 12) for generating a recording synchronizing signal indicating recording start timing from said pre-pit signal.

In regard to claim 2, Yoshida et al. disclose an optical recording apparatus (figure 3) for recording an information data signal on an optical recording medium (figure 3, element 1), comprising: a position identifying portion for identifying the position of a control data recording area where control data regarding recording of said information data signal is recorded (figure 3, element 11); an RF data signal detecting portion (figure 3, element 95) for reading a predetermined section of said control data recording area to detect an RF data signal; and a generating portion (figure 3, elements 14 & 12) for generating a recording synchronizing signal indicating recording start timing from said RF data signal.

In regard to claim 3, Yoshida et al. disclose an optical recording apparatus (figure 3) for recording an information data signal on an optical recording medium (figure 3, element 1), comprising: a position identifying portion for identifying the position of a control data recording area where control data regarding recording of said information data signal is recorded (figure 3, element 11); a pre-pit signal detecting portion (figure 3, element 17) for reading a predetermined section of said control data recording area to detect detecting a pre-pit signal; an RF data signal detecting portion (figure 3, element 95) for reading a predetermined section of said control data recording area to detect an RF data signal; and a selecting portion (figure 4, element SW1) for selecting either of said pre-pit signal detecting portion and said RF data signal detecting portion to generate a recording synchronizing signal indicating recording start timing from the detected signal (see also column 16, paragraph 0089).

In regard to claim 6, Yoshida et al. disclose a method for recording an information data signal on an optical recording medium (figure 3, element 1), comprising the steps of: identifying the position of a control data recording area where control data regarding recording of said information data signal is recorded (inherent: see claim 1 rejection above); detecting a pre-pit signal by reading a predetermined section of said control data recording area (figure 3, element 17); and generating a recording synchronizing signal (figure 3, elements 14 & 12) indicating recording start timing from said pre-pit signal.

In regard to claim 7, Yoshida et al. disclose a method for recording an information data signal on an optical recording medium (figure 3, element 1), comprising the steps of: identifying the position of a control data recording area where control data regarding recording of said information data signal is recorded (figure 3, element 11); detecting an RF data signal by reading a predetermined section of said control data recording area (figure 3, element 95); and generating a recording synchronizing signal (figure 3, elements 14 & 12) indicating recording start timing from said RF data signal.

In regard to claim 8, Yoshida et al. disclose a method for recording an information data signal on an optical recording medium (figure 3, element 1), comprising the steps of: identifying the position of a control data recording area where control data regarding recording of said information data signal is recorded (figure 3, element 11); detecting a pre-pit signal by reading a predetermined section of said control data recording area (figure 3, element 17); detecting an RF data signal by reading a predetermined section of said control data recording area (figure 3, element 95); and executing either one of the step of detecting a pre-pit signal and the step of detecting an RF data signal to generate a recording synchronizing signal indicating recording

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start timing from the detected signal (figure 4, element SW1; see also column 16, paragraph 0089).

In regard to claims 9-11, these claims have limitations that are similar to or inherent from those of claims 3 & 8; thus, they are rejected using the same rationale as applied against claims 3 & 8 above.

In regard to claims 12-17, Yoshida et al. disclose that said control data recording area is a control data zone on said optical recording medium (see paragraph 36, lines 16-21 and item 9 below).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al. in view of Usami et al. (US 5,274,623).

For a description of Yoshida et al., see the 102 rejection above. Yoshida et al., however, remain silent to whether said predetermined section (where a pre-pit signal is read) is positioned at the end of said control data recording area.

Usami et al. disclose in figure 8C that a pre-pit signal is positioned at the end of the control information area. It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to have positioned the predetermined section of Yoshida et al. at the end of the control data recording area, as suggested by Usami et al. The motivation would have

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been to allow reproduction of different types of recording medium using the same recording apparatus.

*Allowable Subject Matter*

7. Claims 4 & 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See the previous Office Action.

*Response to Arguments*

8. Applicant's arguments filed September 13, 2004 have been fully considered but they are not persuasive.

9. In regard to the rejection of claims 1-3 & 6-8, the applicant argues on page 11 that Yoshida et al. fails to teach or otherwise suggest the identification of the position of a control data recording area as claimed. Specifically, the applicant points out that the pre-pit detector of Yoshida et al. does not identify the position of a control data recording area of an optical medium, as claimed. The examiner disagrees. Yoshida et al. describes "prepits corresponding to preinformation" on paragraph 31, line 3; and "obtains **address information** ... from the preinformation", on paragraph 37, lines 16-21. It is well-known in the art that **address information** is a type of control information (see for example Kuroda et al. (US 6,269,059), column 7, lines 61-65). It is also well-known that pre-pits contain control information, see for example Yoshida et al. (US 5,930,222), column 2, lines 35-39; and Isaka et al. (US 5,124,967), column 4, lines 46-49. Therefore, the pre-pit detector of Yoshida et al. identifies the position of a control data recording area when it detects the pre-pits.

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10. In regard to newly added claims 9-17, applicant asserts on page 13, lines 2-4 that none of the prior art references teach or otherwise suggest a controller operable to determine the position of a control data zone on the recording medium, wherein the control data zone stores data regarding recording of the recording information. The examiner disagrees. Figure 3, element 11 of Yoshida et al. is read to correspond to the claimed controller.

*Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent M. Agustin whose telephone number is (703) 305-8980. The examiner can normally be reached on Monday thru Friday 9:00AM - 5:30PM.

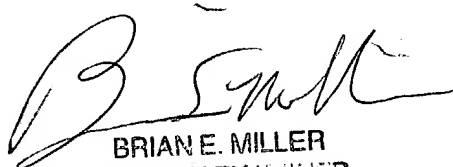
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
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BRIAN E. MILLER  
PRIMARY EXAMINER